

Remarks/Arguments

Claims 1-6 are pending in this application. The Examiner has rejected claims 1-6 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-6 of U.S. Patent No. 6,532,986. Applicant respectfully traverses the rejection.

Applicant asserts that the Examiner has failed to establish a *prima facie* case of statutory double patenting under 35 U.S.C. § 101. The Federal Circuit has set forth a two-prong test for determining the existence of double patenting. See In re Vogel, 422 F.2d 438 (CCPA 1970). The first inquiry is whether the same invention is being claimed twice. Id. at 441; Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355 (Fed. Cir. 1986). "A good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." In re Vogel, 422 F.2d at 441; see also In re Bridgeford, 357 F.2d 679, 682 (CCPA 1966). For example, in In re Vogel the patented claims were limited to "pork". 422 F.2d at 442. The appealed claims were limited to "meat", which was not the same thing and therefore there was no double patenting under 35 U.S.C. § 101.

Such is the case here. The claims of the '986 patent by Dickey are limited to a "T-shaped piston element". (See claims 1 and 3). In contrast, Applicant's claims are limited to "a valve element". (See claims 1 and 4). Claims 1 and 4 of the present application could be infringed by many devices that would not infringe the claims of the '986 patent by Dickey. Therefore, the Examiner's rejection under 35 U.S.C. § 101 should be withdrawn.

Accordingly, as the claims of the present application do not embody the same invention as the claims of the prior art, Applicant

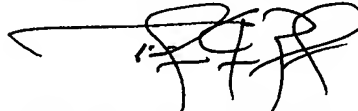
respectfully requests that the Examiner withdraw the rejection based upon statutory double patenting.

Conclusion:

In view of the above amendments and remarks, Applicant believes that claims 1-6 are in condition for allowance, and Applicant respectfully requests allowance of such claims. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515-558-0200.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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